

The Examiner, citing PCT Rule 13.1 and 13.2, contends that a lack of unity exists between Groups I-II, because the special technical feature of the present invention - the polypeptide of Formula I - does not define a contribution over the prior art. To support this assertion, the Office cites Higgins et al from the International Search Report. However, the Office's reliance on the International Search report is misplaced and Applicants point out that the International Preliminary Examination Report (see English translation attached herewith) at paragraph 2.1 states:

"The subject matter of the present invention is the use of Pa1b protein as an insecticide. None of the available documents describe such a use. Therefore, the subject matter of the present application relating to the use of said protein as an insecticide meets the novelty requirements of PCT Article 33(2)."

Applicants respectfully traverse the Restriction Requirement on the ground that unity of invention does exist between Groups I-II because there is a technical relationship that involves the same special technical feature. It is this technical feature that defines the contribution which each of the Groups, taken as a whole, makes over the prior art.

Applicants traverse the Restriction Requirement on the additional grounds that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority. The Authority did not take the position that unity of invention was lacking in the International application and examined all claims together (see the International Preliminary Examination Report appended herewith). Applicants note that PCT Article 27(1) states:

No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

Moreover, Applicants respectfully traverse on the grounds that the Office has not shown that a burden exists in searching the entire application.

MPEP in §803 states as follows:

"If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits,

even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together.

Citing 35 U.S.C. §121, the Office is requiring an election of a single amino acid sequence of the elected group. However, this application is a 371 of international application PCT/FR99/01085, filed May 7, 1999, and is properly subject to restriction only under the PCT rules. As noted in MPEP §1895.01(D), restriction practice under 35 U.S.C. §121, as it applies to national applications submitted under 35 U.S.C. §111(a), is not applicable to a national stage application such as this one. Applicants respectfully point out the PCT administrative instructions in MPEP, Annex B, Part 1, which provide direction on restriction practice under the PCT rules. The Office has not made out a proper case of restriction under the PCT rules, and the Restriction and Election of Species Requirement should be withdrawn.

Even under the PCT rules, the species satisfy the unity of invention standard. The Applicants note that the PCT administrative instructions in the MPEP, Annex B, Part 1(f) define Markush practice and state that the alternatives defined in a single claim shall meet the technical relationship requirements of PCT Rule 13.2 if they are of a similar nature. These alternatives shall be regarded as being of a similar nature when the following criteria are fulfilled:

(A) all the alternatives have a common property or activity, and

(B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

The Office provides no support for its conclusion that the alternative chemical compounds in the claims are so dissimilar that they fail to meet the requirements of PCT Rule 13.2 for Markush practice. Applicants submit that criteria (A) and (B)(1) are met since the amino acid sequences are insecticidal polypeptides and share a common significant structural element: Formula I. Accordingly, they are of similar nature as that term is defined in Annex B above.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction and Election of Species Requirement. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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